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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,971	01/31/2002	Les A. Newman	6926-3	2038

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT PAPER NUMBER

3626

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/061,971	<b>Applicant(s)</b> NEWMAN, LES A.	
	<b>Examiner</b> Vivek D. Koppikar	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/31/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/2/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Status of the Application***

1. Claims 1-22 have been examined in this application. This communication is the first action on the merits. The Information Disclosure Statement (IDS) statement filed on November 2, 2005 has also been acknowledged.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-2, 6, 9-15, 17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,266,648 to Baker, III (hereinafter referred to as Baker).

(A) As per claim 1, Baker teaches a computerized method of managing benefits (Baker: Abstract), comprising the steps of:

receiving benefit data for an insurance plan (Baker: Col. 4, Ln. 5-30)

receiving employee data (Baker: Col. 4, Ln. 5-30);

accepting desired modifications to said employee benefit data and/or said employee data

(Baker: Col. 4, Ln. 5-30);

storing said benefit data and/or said employee data (Baker: Col. 10, Ln. 6-18);

dividing said benefit data and/or said employee data into categories (Baker: Col. 5, Ln. 8-

20);

formatting said benefit data and/or said employee data (Baker: Col. 3, Ln. 1-5 and Col. 5, Ln. 51-62); and

displaying said formatted data (Baker: Col. 3, Ln. 1-5).

The method of Baker does not teach that the benefits are employee benefits, however, the examiner takes the position Official Notice that it is well known in the art to provide a means for an employee to manage their benefits. Moreover, the type of benefits described in Baker are discounts on goods and services and usually many employee benefits are in the form of discounts on goods and services (e.g. group health insurance). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Baker so that the method was used for employee benefits with the motivation of an employer providing a means to their employees of managing their benefits so that they (the employees) could take advantage of discounts, as recited in Baker (Col. 1, Ln. 13-19).

(B) As per claim 2, in Baker the benefit categories are one or more members selected from the group consisting of: workers compensation insurance, medical insurance, dental insurance, vision insurance, prescription drug benefits (consumer goods), profit sharing plans, pension plans, and 401 K plans (Baker: Claim 15).

(C) As per claim 6, Baker teaches the step of extracting desired portions of said stored employee benefit data and said stored employee data for use in other computerized applications (Baker: Col. 6, Ln. 35-47).

(D) As per claim 9, Baker teaches the step of accepting desired modifications to said employee benefit data and/or said employee data (Baker: Col. 10, Ln. 13-17) comprises:

accepting modifications to said employee data wherein said employee data is employee insurance plan enrollment data (Baker: Col. 10, Ln. 13-17).

(E) As per claim 10, in Baker the modification comprises a change in said employee's prescription benefit provider from a first prescription benefit provider to a second prescription benefit provider (Baker: Col. 10, Ln. 13-17).

(F) As per claim 11, in Baker the first prescription benefit provider pays a claim after the modification of said prescription benefit provider to said second prescription benefit provider, said method further comprising:

transmitting said modifications to said enrollment data to said prescription benefit providers (Baker: Col. 10, Ln. 13-17); and

Baker does not teach the step of remitting payment by said second prescription benefit provider to said first prescription benefit provider, however, the examiner takes Official Notice that it is well known in the health care industry that if a patient changes their prescription benefit provider than their first prescription benefit provider will transmit any claims for the remittance of any payment to the second prescription benefit provider. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Baker with the feature so that the patient would receive remittance from the correct prescription benefit provider (the prescription benefit provider they had just changed to).

(F) As per claim 12, in Baker the step of dividing said employee benefit data and/or said employee data into categories comprises: dividing said employee benefit data and said employee data for each covered employee (Baker: Col. 10, Ln. 65-67).

(G) As per claim 13, in Baker the step of formatting said employee benefit data and/or said employee data comprises: summarizing said employee benefit data and/or said employee data for each covered employee (Baker: Col. 3, Ln. 2-5).

(H) As per claim 14, this claim repeats features previously addressed in the rejection of claim 1 and is rejected on the same basis.

(I) As per claim 15, in the system of Baker there is a means for extracting desired data from the system (Baker: Col. 6, Ln. 35-47) and means for transmitting said extracted data among modules of said system (Baker: Col. 6, Ln. 62-Col. 7, Ln. 10).

(J) As per claim 17, this claim repeats features previously addressed in the rejection of claims 1, 9 and 15 and is rejected on the same basis.

(K) As per claim 20, this claim repeats features previously addressed in the rejection of claims 1 and 13 and is rejected on the same basis.

(L) As per claim 21, this claim repeats features previously addressed in the rejection of claims 1 and 9 and is rejected on the same basis.

(M) As per claim 22, this claim repeats features previously addressed in the rejection of claims 1 and 6 and is rejected on the same basis.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, as applied to Claim 2, above, and in further view of US Patent Number 2001/0044735 to Colburn.

(A) As per claims 3-5, Baker does not teach the following features which are taught by Colburn:

the step wherein the employee benefit data is divided into a worker's compensation insurance category and wherein said employee data comprises a worker's compensation claim by an employee (Colburn: Section [0012]);

calculating a present settlement value for said worker's compensation claim; and  
calculating projected medical expenses for said employee (Colburn: Section [0058]).

providing an electronic worker's compensation settlement form for said worker's compensation claim (Colburn: Section [0023]).

At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the method of Baker the these aforementioned features from Colburn with the motivation of an employer having a more enhanced means to audit and monitor their workers' employee compensation claims, as recited in Colburn (Sections [0002]).

(B) As per claims 18-19, these claims repeat features previously addressed in the rejections of claims 3-5 and therefore, these claims are rejected on the same basis.

5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, as applied to Claim 1, above, and in further view of US Patent Number 6,826,536 to Forman.

(A) As per claims 7-8, Baker does not teach the following features which are taught by Forman:

a step of dividing the employee benefit data and/or said employee data into categories (Forman: Col. 13, Ln. 29-40) comprises:

defining categories of health conditions (Forman: Col. 13, Ln. 29-40);

dividing said employee data according to medical claims due to said health conditions (Forman: Col. 13, Ln. 29-40); and

determining the frequency of occurrence of medical claims in each health condition category (Forman: Col. 5, Ln. 5-9 and Col. 12, Ln. 11-18);

identifying employees at risk to file a medical claim based on one or more of said categorized health conditions (Forman: Col. 5, Ln. 5-9 and Col. 10, Ln. 7-12).

At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the method of Baker with these aforementioned features from Forman with the motivation of having a means to analyze a provider's billing behavior, as recited in Forman (Abstract).

Baker and Forman do not teach the step of providing health care prevention services to said identified employees directed to said health condition, however, the examiner takes Official Notice that it is well known to provide preventative services to high-risk groups so that later on these groups' claims will be less. This is analogous to providing people with a certain genetic predisposal to a certain disease with preventative care so that they do not develop the disease. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Baker in view of Forman with this feature with the motivation of reducing the amount of health care claims from high risk groups.

(B) As per claim 16, this claim repeats features previously addressed in the rejection of claims 7-8 and is rejected on the same basis.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.




If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

  
Vivek Koppikar

3/7/2006

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER